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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,163	01/24/2002	Scott H. Robinson	42390.P12878	1704

7590 04/19/2007  
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EXAMINER
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TRAN, PHILIP B

ART UNIT	PAPER NUMBER
2155	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/057,163

**Applicant(s)**

ROBINSON ET AL.

**Examiner**

Philip B. Tran

**Art Unit**

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **Response to Request for Consideration**

### ***Notice to Applicant***

1. This communication is in response to Remarks filed 12 January 2007. No claims have been amended or canceled. Therefore, claims 32-49 are pending for further examination.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 32-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (Hereafter, Smith), U.S. Pat. No. 6,697,842 in view of Yu, U.S. Pat. Application Pub. No. US 2002/0143757 A1.

Regarding claim 32, Smith teaches a method comprising evaluating a communication network context and prioritizing a plurality of information items based on at least the communication network context (= dynamically processing and filtering data for adapted content being sent to the mobile client) [see Smith, Abstract and Fig. 4 and Col. 4, Line 25 to Col. 5, Line 36].

Smith further teaches transferring data from the server to the mobile client via a service provider [see Smith, Abstract and Fig. 1]. However, Smith does not explicitly teach transferring at least one high priority information item and subsequently transferring at least one additional information item for future use.

Yu, in the same field of dynamic managing context endeavor, discloses prioritization scheme for sending high priority items to the user first before other items are presented [see Yu, paragraph 0004]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of prioritization scheme of Yu into the teaching of dynamic processing and filtering context of Smith in order to transfer filtered data to the user in such an efficiently prioritized manner. Thus, more important items will be transmitted with higher priority to reduce the traffic congestion in the network.

Regarding claim 33, Smith further teaches the method of claim 32, further comprising evaluating a communication device context [see Col. 2, Lines 7-24].

Regarding claim 34, Smith further teaches the method of claim 33, further comprising evaluating a user context [see Abstract and Col. 4, Line 65 to Col. 5, Line 18].

Regarding claim 35, Smith further teaches the method of claim 34, further comprising filtering the plurality of information items based on at least one of the communication network context, the communication device context, and the user context [see Abstract and Fig. 4 and Col. 4, Line 25 to Col. 5, Line 36].

Regarding claim 36, Smith further teaches the method of claim 34, further comprising reprioritizing information items when a change in at least one of the communication network context, the communication device context, and the user context is detected [see Col. 4, Line 65 to Col. 5, Line 36 and Col. 6, Lines 5-67].

Regarding claim 37, Smith and Yu do not explicitly teach cancelling a planned information item transfer when a change in at least one of the communication network context, the communication device context, and the user context is detected. However, it would have been obvious to one skilled in the art to recognize that service delivery cancellation is a part of context filtering process.

Regarding claim 38, Smith and Yu do not explicitly teach subsequently transferring at least one additional information item for future use comprises transferring

at least one information item over multiple connectivity sessions. However, it would have been obvious to one skilled in the art to recognize that multiple connectivity sessions can be implemented for transferring data in the network.

Claim 39 is rejected under the same rationale set forth above to claim 32.

Regarding claim 40, Smith further teaches the machine readable medium of claim 39, wherein the set of instructions, which when executed, further cause the machine to partition the plurality of information items into sets prior to transfer of the high priority information items [see Col. 4, Line 65 to Col. 5, Line 36 and Col. 6, Lines 33-67 and Col. 7, Lines 1-17].

Claim 41 is rejected under the same rationale set forth above to claim 33.

Claim 42 is rejected under the same rationale set forth above to claim 35.

Claim 43 is rejected under the same rationale set forth above to claim 36.

Claim 44 is rejected under the same rationale set forth above to claim 37.

Claim 45 is rejected under the same rationale set forth above to claim 38.

Claim 46 is rejected under the same rationale set forth above to claim 39.

Claim 47 is rejected under the same rationale set forth above to claim 43.

Claim 48 is rejected under the same rationale set forth above to claim 45.

Regarding claim 49, Smith further teaches the system of claim 46, wherein the transfer of high priority information items to a user device occurs over a wireless network connection [see Fig. 1].

### ***Response to Arguments***

4. Applicant's arguments have been fully considered but they are not persuasive because of the following reasons:

Applicant argued that the context filtering performed by Smith (U.S. Pat. No. 6,697,842) is not the same as the evaluating of a communication network context as taught and claimed by applicant because Smith does not disclose evaluating information about the communication mediums available. Applicant also argued that Yu (U.S. Pat. Application Pub. No. US 2002/0143757 A1) does not disclose evaluating information about the communication mediums available. Therefore, neither Smith nor Yu teach or suggest evaluating a communication network context [see Page 8 of Remarks].

*In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., evaluating information about the communication mediums available) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See **In re Van Geuns**, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).*

In addition, Smith teaches a method comprising evaluating a communication network context and prioritizing a plurality of information items based on at least the communication network context. That is, Smith discloses dynamically processing and filtering data for adapted content being sent to the mobile client [see Smith, Abstract and Fig. 4 and Col. 4, Line 25 to Col. 5, Line 36]. Smith further teaches transferring data from the server to the mobile client via a service provider [see Smith, Abstract and Fig. 1]. However, Smith does not explicitly teach transferring at least one high priority information item and subsequently transferring at least one additional information item for future use.

Yu, in the same field of dynamic managing context endeavor, discloses prioritization scheme for sending high priority items to the user first before other items are presented [see Yu, paragraph 0004]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of prioritization scheme of Yu into the teaching of dynamic processing and filtering context of Smith in order to transfer filtered data to the user in such an efficiently prioritized manner. Thus, more important items will be transmitted with higher priority to reduce the traffic congestion in the network.

Therefore, the examiner asserts that the cited prior arts teach or suggest the subject matter recited in independent claims. Dependent claims are rejected at least by virtue of their dependency on independent claims and by other reasons set forth above. Accordingly, claims 32-49 are respectfully rejected as shown above.



***Conclusion***

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

**A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CAR 1.136(A) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT, HOWEVER, WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE MAILING DATE OF THIS FINAL ACTION.**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991. The Group fax phone number is (571) 273-8300. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar, can be reached on (571) 272-4006.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Philip B. Tran  
Primary Examiner  
Art Unit 2155  
April 13, 2007